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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,139	11/21/2001	Yukio Nishikawa	YMOR:229	9445

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

5

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/989,139

Applicant(s)
NISHIKAWA ET AL.

Examiner
LA VILLA

Art Unit
1775



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 2-9 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10-12, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 1, 10-12, 19, and 20 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the subject matter of all pending claims is sufficiently related that a complete and thorough search of the subject matter of the elected claims would encompass a complete and thorough search of the subject matter of the non-elected claims. Applicant contends that searching all claims would not constitute a serious burden. This is not found persuasive because a serious burden is demonstrated by showing that claims in the different groups are separately classified and that the search of one group is not the same as the search of another. Applicant has not traversed the appropriateness of the separate classifications. Moreover, the required search for each group would be different. A complete and thorough search for each group would require a review of class/subclass combinations that is not required for any of the other groups.
2. Claims 2-9 and 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.
3. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 10-12, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - I. Regarding Claims 10 and 19, it is unclear what is meant by the phrase "desired shape." Does this mean deliberately made or aesthetically acceptable? Which shapes would be undesirable? It is unclear what constitutes a "cut surface." Is this a process limitation on how a surface is to be prepared or is this a description of a discontinuity in the outer surface of the molded body?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
8. A person shall be entitled to a patent unless –
9. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schmeling et al. USP 4,976,830. Schmeling teaches a magnesium body coated with a ceramic layer and a water glass layer. The ceramic layer may be identified with the nonmetal anticorrosive layer and the water glass layer may be identified with the transparent painted film. Schmeling does not indicate that the magnesium body was molded, but it would be expected that the solid magnesium body would be indistinguishable from a molded body were it not molded. See Abstract; col.

3, line 55 through col. 4, line 36; col. 4, line 61 through col. 5, line 53 in Schmeling.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Schmeling et al. USP 4,976,830. Schmeling teaches a magnesium body coated with a ceramic layer and a paint layer. The ceramic layer may be identified with the nonmetal anticorrosive layer. Schmeling does not indicate that the magnesium body was molded, but it would be expected that the solid magnesium body would be indistinguishable from a molded body were it not molded. See Abstract; col. 3, line 55 through col. 4, line 36; col. 4, line 61 through col. 5, line

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53 in Schmeling. Schmeling does not exemplify organic coating layers, but does teach that they may be used. It would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate the article of Schmeling with the organic paint layers of Schmeling as Schmeling teaches that such layers form effective outer layers resistant to corrosion. Since the layers are not disclosed as darkened, it would be expected that they would inherently possess some transparency.

14. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al. USPA 2001/0020498. Seki teaches a magnesium molded body provided with an oxide layer and a clear paint layer to confer corrosion resistance, but does not exemplify forming the oxide and paint layers. See Abstract; paragraphs 37-44, 85-88, and 164-167 in Seki. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the oxide coating and paint layers on the molded magnesium body of Seki as Seki teaches that application of these layers confers favorable corrosion resistance to the magnesium body.

15. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baer USP 3,887,449. Baer teaches coating a magnesium alloy substrate with a two-layered epoxy coating and optionally a clear coat epoxy layer. See col. 4, lines 3-18 and 37-53; and col. 5, line 40 through col. 6, line 3 in Baer. Baer does not indicate that the magnesium body was molded, but it would be expected that the solid magnesium body would be indistinguishable from a molded body were it not explicitly molded. It would have been obvious to one of ordinary skill in the art at

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the time of the invention to apply a clear epoxy overcoat as Baer teaches that clear epoxy overcoats are desirable for additional protection.

CONCLUSION

16. The subject matter of Claims 12, 19, and 20 does not appear to be anticipated or rendered obvious in view of the prior art of record or the other reviewed prior art.

With respect to Claims 10-12, 19 and 20, the key feature of an intermediate layer that consists of organic acid amine salt is not taught or suggested.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (703) 308-4428. The examiner can normally be reached on Monday through Friday.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael La Villa
April 3, 2003

